



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,856	10/24/2003	Thomas J. Perkowski	100-061USA000	8135
84704	7590	03/10/2009	EXAMINER	
Thomas J. Perkowski, Esq., P. C. Soundview Plaza 1266 East Main Street Stamford, CT 06902			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	
			MAIL DATE	DELIVERY MODE
			03/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 12/15/2008.

Double Patenting

2. Applicant has created quite a tangled web of similarly-focused pending applications, many of which are being examiner by this examiner. There appears to be no apparent rhyme or reason why so many applications are copending, nor any focus on any particular inventive twist or direction specific to each case, thus failing to create a clear line of demarcation between the applications. See MPEP § 822. For this reason, there are an overwhelming amount of overlapping claims and concepts which are subject to the following double patenting issues.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 3622

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 63-70,72,74,75,77-85,87 and 88 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the following claims of the following copending applications.

<u>Application</u>	<u>Claims</u>
11/804769	1-19
10/876261	154-170
10/812341	31-57
10/059078	49-58
10/602990	63-107
11/823828	8-21, 37-53
10/059076	78-99
10/058970	98-115
09/695744	478-489
09/716848	497-507
10/059076	78-99
10/058970	98-115
09/695744	478-489

5. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

- It would have been obvious to one of ordinary skill at the time of the invention to have provided such a system whether it is for offered products identified by product name, description, trademark or for offered services identified by service names, descriptions and service marks.
- It would have been obvious to one of ordinary skill at the time of the invention to have characterized a BIN network with UPN/TM and URLs in a similar fashion as a collection of CPI links (URLs) in association with UPN/TM.

- A catalog of MMVK tags is taken to be equivalent to a library of MMVK tags and it would have been obvious to one of ordinary skill at the time of the invention to have employed a collection of tags so that the system can properly link to a URL (by a well known HTML tag) so that the consumer can request and receive product information for a particular product.
- It would have been obvious to one of ordinary skill at the time of the invention to have programmed the display modes of the MMVKs so that they deliver "information resources" as relevant to the consumer-requested product or service.

6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 63-70,72,74,75,77-85,87 and 88 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 63 – “plurality of...resources...program said set of...resource” is circular and generally unclear.
- Claims 63 and 77 and their dependant claims are system (apparatus) claims, yet they include many features which are presented as method steps rather

than capabilities, rendering the claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to <perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act. Exemplary, but not exhaustive examples are as follows:

- Claim 63, 77 – resources program; first internet-enabled information server generates and serves; browser displays a GUI; browser of a consumer processes said MMVK tag; said first internet-enabled information server executes...and generates and serves; said MMVK automatically plays; inviting and allowing the consumer to review and interact.
- Claim 64, 77 – MMVK automatically displays; product can be purchased...and delivered. Does the system provide structure for delivery of a product to a physical address?
- Claims 65, 77 - so as to help analyze effectiveness.
- Claim 78 – MMVK automatically plays.
- Claim 72, 85, browser is responsive to the consumer clicking; it is further not clear whether applicant is attempting to actually claim the user's web browser as part of the apparatus claim – and if so, what browser capability is being claimed? If not, it is unclear in what way the apparatus/system is being further limited.

- Claim 74 – system is used to import.
- Claims 64, 77, the “and/or” renders the claim scope uncertain.
- Claim 70, 83, there is no antecedent basis for said set of display attributes.
- Claim 84, it is unclear how the system can be structurally limited by the choice of a user’s client machine; what feature of the system is being further defined here?
- Claim 72, 85, it is unclear how the system can be structurally limited by the choice of a user’s actions of clicking. Is this a method step? What feature of the system is being further defined here?
- Claim 74, 87, there is no antecedent basis for TM or PD.

Allowable Subject Matter

7. As best understood, claims 63-70,72,74,75,77-85,87 and 88 appear to be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc